

REMARKS

Claims 1-32 are pending in the application; claims 21-30 are withdrawn from consideration; claims 4 and 5 are allowed; claims 6-18, 31 and 32 are objected to and claims 1-3 are rejected.

The Examiner required a restriction under 35. U.S.C.121 to one of:

Group I -- Claims 1-20 and 31-32, drawn to a method of producing a pattern; and

Group II-- Claims 21-32, drawn to an element.

The Applicant hereby affirms the election of Group 1, claims 1-20 and 31-32, drawn to a method of producing a pattern, with traverse.

The Applicant requests reconsideration of the restriction requirement because, as argued below, the method is novel and not disclosed in any references known to the inventors and offers advantages not offered by prior art methods. The novel method was designed for use in making the element claimed. Although the method might conceivably be used to make a different product, as the Examiner suggests, such use is speculative and success highly unpredictable, especially since the mechanism for how the conductivity enhancing agents actually work is not well understood and how electroconductive polymers are affected by conductivity enhancing agents is unknown.

Further, the method of making a pattern and the element made are so closely related that a search for one would necessarily overlap the search for the other. It would therefore not be burdensome for the Examiner to examine both groups of claims together, thereby achieving greater economy of time and money to the Applicant and the Office. The Applicant urges reconsideration of the restriction requirement.

The Applicant has updated the cross reference information in the first paragraph of the specification, as requested by the Examiner.

The Applicant has also amended the disclosure to include the material incorporated by reference on page 13, lines 7-9 of the disclosure, as requested by the Examiner. The Applicant's attorney hereby states that the material inserted is the material previously incorporated by reference from Research Disclosure Volume 109, Index No. 10938 published May 1973, and that the amendment contains no new matter.

Claim 1 has been rejected under 35 U.S.C. 112, first paragraph, for the use of the term “or precursors thereof” which is allegedly not enabled. The Applicant has amended the claim and deleted this language thus overcoming the rejection. The Applicant requests that the rejection now be withdrawn.

Claims 1-3 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikeuchi et al. Directing the Applicant’s attention to col. 7 and col. 8, the Examiner argues that the reference teaches the importance of the resistance of a sheet in an electrographic process in the making of a conductive image and a polythiophene is used to control the resistance of the image. The toner, the Examiner points out, “can have the electrification control agent”. This rejection is respectfully traversed.

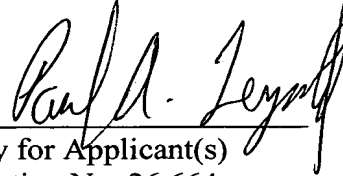
Ikuechi et al. refer to polythiophene as being a suitable "electrification control agent" (col. 8, line 9). Also, the Examiner points to col. 11, lines 14-20 where the reference teaches that the toner can have the electrification control agent. Based on the prior statement in col. 8, Ikuechi et al. teaches that the toner can have the polythiophene. This is very different than instant claim 1 where the Applicant teaches that the marking particles (i.e., toner) contain a conductivity modifier and NOT the polythiophene, as taught by the reference. In present claim 1, the conductivity modifier-containing toner particles are transferred onto a separate conductive layer, and it is the conductive layer that contains the polythiophene.

The prior art cited by the Examiner does not describe or even mention the use of conductivity modifiers to alter the conductivity of a polythiophene layer, which is the critical feature of the present invention. The prior art teaches only that the toner particles contain polythiophene; it does not teach toner particles containing conductivity modifiers for patterning a separate layer. In the present invention, it is this second layer that contains polythiophene. A rereading and comparison of the two teachings would be persuasive and would compel the Examiner to withdraw the rejection. The Applicant respectfully requests that the rejection be withdrawn.

Claims 1, 4, 21-23 and 25-30 have been provisionally rejected under the doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 and 32 of co-pending application No 10/648,420. The Terminal Disclaimer submitted with this response will overcome the rejection.

The Examiner is respectfully urged to withdraw the rejections and issue an early Notice of Allowability.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Paul A. Leipold", written over a horizontal line.

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